

**REMARKS**

Reconsideration of the application as amended is respectfully requested.

Axelrod ('771) fails to anticipate the claims of the present invention, as Axelrod ('771) fails to disclose a micro-porous body having an enriching agent impregnated therein as recited in claim 1. In particular, Axelrod ('771) discloses an extruded toy formed of solid thermoplastic with visible particles of animal suspended and dispersed throughout the thermoplastic. (Column 2, Lines 54-56, and FIG. 1). The disclosure of a solid thermoplastic material does not anticipate the micro-porous body disclosed in claim 1. Therefore, claim 1 is patentably distinguishable over Axelrod ('771). Because claims 2-7 depend directly or indirectly from claim 1, claims 2-7 are likewise patentably distinguishable over Axelrod ('771).

In addition, Axelrod ('771) fails to anticipate claim 2 by failing to disclose the use of a raw (real) animal bone for impregnation of the enriching agent. Axelrod ('771) discloses the use of thermoplastics to form a bone, but fails to disclose the use of a real animal bone. As such, claim 2 is patentably distinguishable over Axelrod ('771).

Axelrod ('733) fails to anticipate the claims of the present invention, as Axelrod ('733) fails to disclose a micro-porous body having an enriching agent impregnated therein as recited in claim 1. In particular, Axelrod ('733) discloses a dog bone formed of a thermoplastic polyurethane resin. As indicated in Axelrod ('733), the formation of carbon dioxide gas during the manufacturing process, resulting from the exposure of isocyanate end groups reacting with moisture, results in "undesirable porosity", or a closed cell structure permitting only limited penetration of the agents, in the formation of the chewable object. (Column

Utility Patent  
Ser. No. 10/611,821

3, Lines 46-51). The undesirability of porosity in Axelrod ('733) fails to anticipate the micro-porosity disclosed in claim 1. Thus, claim 1 is patentably distinguishable over Axelrod ('733). Because claims 2-7 depend directly or indirectly from claim 1, claims 2-7 are likewise patentably distinguishable over Axelrod ('733).

In addition, Axelrod ('733) fails to anticipate claim 2 by failing to disclose the use of a raw (real) animal bone for impregnation of the enriching agent. Axelrod ('733) discloses the use of polyurethane elastomeric to form a bone, but fails to disclose the use of a real animal bone. As such, claim 2 is patentably distinguishable over Axelrod ('733).

Axelrod ('771 & '733) fail to teach every element of claims 4-6. As indicated by the examiner, Axelrod ('733) is entirely silent to the use of enriching agents. Axelrod ('771) discloses prior art that incorporates anti-microbial agents into the product. However, the prior art referenced (Boyer) discloses an oxhide strip impregnated by such agents, in contrast to the solid thermoplastic material recited in Axelrod ('771). There is no motivation or suggestion of combining the teachings of Axelrod ('771) with the internally referenced art for the purpose claimed by the present invention, since the combination of Axelrod ('771) and the internal reference would defeat the intention of impregnating an article with an agent, having no means for egress until the solid thermoplastic material is pierced. Likewise, reference is made to an animal food product consisting of structure supporting fibers formed of collagen or cellulosic material containing dried meats, food additives, vitamins, minerals or medicinal supplements. However, the present invention claims the impregnation of vitamins and minerals into a micro-porous body, not of a body formed

Utility Patent  
Ser. No. 10/611,821

of collagen or cellulose. Thus, the combination further fails for failing to disclose the elements disclosed in claims 4-6.

Based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. § 103(a), in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument applicant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. § 103(a), the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132,

Utility Patent  
Ser. No. 10/611,821

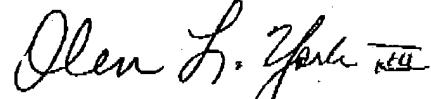
227 USPQ 543 (Fed. Cir. 1985). There is nothing in the prior art or the Examiners arguments that would suggest the desirability or obviousness of making a pet mastication article having a micro-porous body and an enriching agent impregnated into said body. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (Fed. Cir. 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (Fed. Cir. 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (Fed. Cir. 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (Fed. Cir. 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (Fed. Cir. 1988).

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and a formal Notice of Allowance is respectfully requested at the earliest possible date.

Utility Patent  
Ser. No. 10/611,821

Respectfully submitted,



Olen L. York, III, Esq.  
Registration No. 53,814

202 Delaware Building  
137 South Main Street  
Akron, OH 44308  
(330) 253-5678  
Facsimile (330) 253-6658